APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,955	01/26/2006	Lutz Wolfgang Gruneberg	051082	8456

20306   7590   12/11/2009
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER
KARIKARI, KWASI

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
12/11/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 September 2009</u>.

2a)☒ This action is FINAL.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/18/2009</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments, filed on 09/11/2009 with respect to claims 1-19 in the

remarks, have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2.   Claims 7-9 are neither open-ended nor closed-ended because they are missing

transitional phrases such as "consisting" or "comprising". Appropriate corrections are

required to address any ambiguities in the claims.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession

of the claimed invention. The amended claimed limitations "the default configuration

settings being...and are not associated with a user of the terminal", "on half of unique

user" and "to retrieve emails...said default configuration settings", are not clearly

described in the specification as originally filed and this constitute new matter. For

examination purposes, the Examiner would interpret the amended limitations in the

broadest scope of Applicant's invention. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

> The factual inquiries set forth in *Graham* v. *John Deere* Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

> 1.   Determining the scope and contents of the prior art.

> 2.   Ascertaining the differences between the prior art and the claims at issue.

> 3.   Resolving the level of ordinary skill in the pertinent art.

> 4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stoifo et al., (US 20010034709 A1), (hereinafter, Stoifo) in view

of O'Rourke et al., (US 7,173,933, B1), (hereinafter O'Rourke).

Regarding claims 1 and 10, Stoifo teaches a system/method for handling email

requests <u>received from a terminal</u>, the system (= user computer 101; user email

address; and contact of user via proxy email address, see [0005, 0011 and 0024]);

comprising:

at least one email proxy and a database, the email proxy being configured to communicate with the database (= portal server 107 uses an identity bank, see [0012, 0021 and Fig. 2], whereby the "email proxy" is being associated with portal server 107),

wherein the email proxy is configured to detect a unique network address of the terminal (= user sends true identification such IP address to the portal server 107, see [0011]) and

retrieve email configuration settings from the database using the unique network address of the terminal (= portal server 107 assigns proxy identification that matches user's identification, see [0004, 0012, 0021 and 0025]; whereby the proxy identification is being associated with the "email configuration settings") and,

without sending the retrieved email configuration settings back to the terminal, to communicate with an email server using the retrieved email configuration settings (= portal server 107 uses the proxy identification to forward the request message to Web server 103; and the Web server computer can be browsed once links between computer 101, portal server and Web server 103 have been established, see [0012, 0019 and 0030]).

Stoifo explicitly fails to disclose, "sending <u>email from</u> and receiving email <u>by the</u> terminal"

However, **O'Rourke** which is an analogous art, equivalently mentions, "sending <u>email from</u> and receiving email <u>by the</u> terminal" (= user 12 initiates a request for a piece of data or for information, see col. 10, lines 35-51; the request is forwarded to web server 40, see col. 11, lines 10-17; web server 40 may be provided as part of large

package of internet and intranet-related programs for serving email, see col. 9, lines 20-32; and the requested information is communicated back to user 12, see col. 11, lines 10-17).

It would therefore have been obvious at the time the invention was made for one of the ordinary skill in the art to have combined the teaching of O'Rourke with the system of Stoifo for the benefit of achieving a system that accurately identifies users in the a communication system.

Regarding claims 4 and 13, as recited in claims 1 and 10, **Stoifo** further discloses the system wherein the database comprises a mapping of the unique network address of the terminal to an identity of a user (= portal server 107 assigns proxy identification that matches user's identification, see [0004, 0012 and 0021]).

Regarding claims 5 and 14, as recited in claims 4 and 13, **Stoifo** further discloses the wherein a first database comprises the mapping of the unique network address of the terminal to the identity of the user, and second database comprises the retrieved email configuration settings (see [0021]).

Regarding claims 6 and 15, as recited in claims 1 and 10, **Stoifo** further disclose that a first email proxy is used to handle email requests for retrieving email messages, and a second email proxy is used to handle email requests for sending email messages

(= portal server 107, Web server computer 103; and user email address, see [0004,

0011-12 and 0024]).

Regarding claim 7, Stoifo discloses an email retrieval proxy for handling <u>an</u> email

retrieval <u>request received</u> from a terminal (= user computer 101; user email address;

and contact of user via proxy email address, see [0005, 0011 and 0024]),

     <u>wherein</u> the email retrieval proxy is configured to detect a unique network

address of the terminal (= user sends true identification such IP address to the portal

server 107, see [0011]) and retrieve email configuration settings from a database using

the unique network address of the terminal without sending the retrieved email

configuration settings back to the terminal, (= portal server 107 assigns proxy

identification that matches user's identification, see [0004, 0012, 0021 and 0025];

whereby the proxy identification is being associated with the "email configuration

settings"), <u>and</u>

     the email retrieval proxy is further configured to <u>modify the email retrieval request</u>

<u>using the retrieved email configuration settings</u>, forward the <u>modified</u> email retrieval

request to an email server using the retrieved email configuration settings, and to

<u>receive</u> an email message from the email server (= portal server 107 uses the proxy

identification to forward the request message to Web server 103; and the Web server

computer can be browsed once links between computer 101, portal server and Web

server 103 have been established, see [0012, 0019 and 0030]).

Stoifo explicitly fails to disclose, "receiving email by the terminal; and forward the received email message to the terminal"

However, **O'Rourke** which is an analogous art, equivalently mentions, "receiving email by the terminal; and forward the received email message to the terminal" (= user 12 initiates a request for a piece of data or for information, see col. 10, lines 35-51; the request is forwarded to web server 40, see col. 11, lines 10-17; web server 40 may be provided as part of large package of internet and intranet-related programs for serving email, see col. 9, lines 20-32; and the requested information is communicated back to user 12, see col. 11, lines 10-17).

It would therefore have been obvious at the time the invention was made for one of the ordinary skill in the art to have combined the teaching of O'Rourke with the system of Stoifo for the benefit of achieving a system that accurately identifies users in the a communication system.

Regarding claim 8, Stoifo discloses an email sending proxy for handling an email sending request received from a terminal (= user computer 101; user email address; and contact of user via proxy email address, see [0005, 0011 and 0024]),

wherein the email sending proxy is configured to detect a unique network address of the terminal (= user sends true identification such IP address to the portal server 107, see [0011]) and retrieve email configuration settings from a database using the unique network address of the terminal without sending the retrieved email configuration settings back to the terminal, (= portal server 107 assigns proxy

identification that matches user's identification, see [0004, 0012, 0021 and 0025];

whereby the proxy identification is being associated with the "email configuration

settings"), and

wherein the email sending proxy further being configured to modify the email

sending request using the retrieved email configuration settings and to forward the

modified email sending request to an email server using the retrieved email

configuration settings (= portal server 107 uses the proxy identification to forward the

request message to Web server 103; and the Web server computer can be browsed

once links between computer 101, portal server and Web server 103 have been

established, see [0012, 0019 and 0030]).

Stoifo explicitly fails to disclose, "sending email from the terminal"

However, **O'Rourke** which is an analogous art, equivalently mentions, sending

email from the terminal" (= user 12 initiates a request for a piece of data or for

information, see col. 10, lines 35-51; the request is forwarded to web server 40, see col.

11, lines 10-17; web server 40 may be provided as part of large package of internet

and intranet-related programs for serving email, see col. 9, lines 20-32; and the

requested information is communicated back to user 12, see col. 11, lines 10-17).

It would therefore have been obvious at the time the invention was made for one

of the ordinary skill in the art to have combined the teaching of O'Rourke with the

system of Stoifo for the benefit of achieving a system that accurately identifies users in

the a communication system.

Regarding claim 9, Stoifo discloses a terminal for use with a system of claim 1

(= user computer 101; user email address; and contact of user via proxy email

address, see [0005, 0011 and 0024]), the terminal being provisioned with default

configuration settings for sending or retrieving email messages (= portal server 107

assigns proxy identification that matches user's identification, see [0004, 0012, 0021

and 0025]; whereby the proxy identification is being associated with the "default

configuration setting"), the default configuration settings being the same for each mobile

terminal operating within a network <u>and are not associated with a user of the terminal</u>,

wherein the mobile terminal is configured to send email messages to or retrieve email

messages from an email server <u>on behalf of a unique user</u>, via an email proxy, using

the default configuration settings (= proxy identities are reuse by different user, portal

server 107 uses the proxy identification to forward the request message to Web server

103; and the Web server computer can be browsed once links between computer 101,

portal server and Web server 103 have been established, see [0012, 0019, 0022 and

0030]).

Stoifo explicitly fails to disclose, "<u>retrieve emails associated with the user and</u>

<u>send emails from the user using only said default configuration settings.</u>"

However, **O'Rourke** which is an analogous art, equivalently mentions, "<u>retrieve</u>

<u>emails associated with the user and send emails from the user using only said default</u>

<u>configuration settings</u>" (= user 12 initiates a request for a piece of data or for

information, see col. 10, lines 35-51; the request is forwarded to web server 40, see col.

11, lines 10-17; web server 40 may be provided as part of large package of internet

and intranet-related programs for serving email, see col. 9, lines 20-32; and the

requested information is communicated back to user 12, see col. 11, lines 10-17).

      It would therefore have been obvious at the time the invention was made for one

of the ordinary skill in the art to have combined the teaching of O'Rourke with the

system of Stoifo for the benefit of achieving a system that accurately identifies users in

the a communication system.

Regarding claim 16, as recited in claim 1, **Stoifo** further disclose, wherein the email

proxy is further configured to, responsive to receiving an email request from the terminal

containing default values not associated with a user of the terminal, replace the default

values with values associated with the user of the terminal from the retrieved email

configuration settings prior to communicating with the email server using the retrieved

email configuration settings (see [0004, 0012 and 0021]).

Regarding claim 17, as recited in claim 7, **Stoifo** further disclose, wherein the email

retrieval proxy is further configured to, responsive to receiving the email request from

the terminal containing default values not associated with a user of the terminal, replace

the default values with values associated with the user of the terminal from the retrieved

email configuration settings prior to forwarding the modified email retrieval request to

the email server using the retrieved email configuration settings (see [0004, 0012 and

0021]).

Regarding claim 18, as recited in claim 8, **Stoifo** further disclose, wherein the email

sending proxy is further configured to, responsive to receiving the email sending request

from the terminal containing default values not associated with a user of the terminal,

replace the default values with values associated with the user of the terminal from the

retrieved email configuration settings prior to forwarding the modified email sending

request to the email server using the retrieved email configuration settings (see [0004,

0012 and 0021]).

Regarding claim 19, as recited in claim 10, **Stoifo** further disclose, responsive to

receiving an email request from the terminal containing default values not associated

with a user of the terminal, replacing the default values with values associated with the

user of the terminal from the retrieved email configuration settings prior to

communicating with the email server using the retrieved email configuration settings

(see [0004, 0012 and 0021]).

5.   **Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Stoifo in view of O'Rourke and further in view of Applicant's
Admitted Prior Art (hereinafter, AAPA).**

Regarding claim 2, as recited in claim 1, **Stoifo and O'Rourke** do not explicitly teach

about email configuration settings including -- a name of an email server, and a

username and a password for accessing the email server, as claimed by applicant.

However, **APA**, teaches that -- a name of an email server, a user name and a password are known to be used for email retrieval (see page 2, lines 1-4. (7).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of APA with Stoifo and O'Rourke to achieve a system that uses a name of an email server, a user name and a password for email retrieval.

Regarding claim 3, as recited in claim 2, **Stoifo and O'Rourke** do not explicitly teach the system, wherein the email configuration settings further include: a full name of a user and an email address of the user.

However, **APA**, teaches the system, wherein the email configuration settings further include: a full name of a user (see page 2, lines 16-20), and an email address of the user (see page 2, lines 16-20).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of APA with Stoifo and ORourke to achieve a system that uses a name of an email server, a user name and a password for email retrieval.

Regarding claim 11, as recited in claim 10, the features of claim 11 are similar to the features of claim 2. Hence, claim 11 is rejected on the same ground and motivation as claim 2.

Regarding claim 12, as recited in claim 11, the features of claim 12 are similar to the features of claim 3. Hence, claim 12 is rejected on the same ground and motivation as claim 3

CONCLUSION

See attached form PTO-892 for cited references and the prior art made of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of 33the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the

PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to

the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).

/Kwasi Karikari/
Patent Examiner: Art Unit 2617.

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617